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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,762	09/26/2003	Rajdeep S. Kalgutkar	58634US002	1048
32692	7590	08/11/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			BERMAN, SUSAN W	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 08/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/672,762

Applicant(s)

KALGUTKAR ET AL.

Examiner

Susan W. Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12, 17-25 and 27-44 is/are pending in the application.
- 4a) Of the above claim(s) 24, 25 and 27-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 17-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/05</u> . | 6) <input type="checkbox"/> Other: _____  |

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***Response to Amendment***

The rejection of claims 1, 4-6, 11, 13-15, 17, 18, 20 and 21-23 under 35 U.S.C. 102(b) as being anticipated by Kawashima et al (5,486,544) is withdrawn. The rejection of claims 1, 4-6, 11, 13-15 and 17-23 under 35 U.S.C. 103(a) as being unpatentable over Farid et al (4,859,572) in view of Kawashima et al is withdrawn. Kawashima et al disclose polymerizable compositions comprising ammonium aryl sulfates; however, there is no mention of arylsulfates having a phosphorus-containing cation of formula III or a nitrogen-containing cation as defined in instant claim 1.

***Election/Restriction***

The election of species requirement with respect to the claims of Invention Group I is hereby withdrawn. Claims 2, 3, 7-10 are hereby rejoined with the claims of the elected invention.

This application contains claims 24-39 drawn to an invention nonelected with traverse in the Remarks filed 06-29-2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

***Response to Arguments***

Applicant's arguments filed 06-29-2005 have been fully considered but they are not persuasive with respect to the provisional rejection of claims under obviousness-type double patenting over claims of copending 10/672,554, 10/672,814 and 10/847,523.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 12 and 17-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/672,554. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The differences between the claims of Application No. 10/672,554 and the instant claims are (1) the oxidation potential of the electron donor is not set forth and (2) the electron acceptor is limited to a triarylsulfonium salt in the claims of '554. The arylsulfonate salts recited in both applications is the same and thus has the same oxidation potential. Farid et al (4,859,572) disclose an initiator system for ethylenically unsaturated components comprising an electron acceptor activator, an electron donor activator and a dye photosensitizer. The electron donor can be an arylsulfonate (column 8, line 7). Electron acceptor compounds include sulfonium salts and iodonium salts (column 8, lines 51-68). It would have been obvious to one skilled in the art at the time of the invention to substitute other known electron acceptors, such as an iodonium salt, for the sulfonium salt set forth in the claims of '554 in compositions comprising an electron donor such as the recited arylsulfonate salt set forth in the claims of

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'554 and in instant claims, as taught by Farid et al. Farid et al provide motivation by teaching that sulfonium salts and iodonium salts are useful electron acceptor compounds.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-10, 12 and 17-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/672,814. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The difference between the claims of Application No. 10/672,814 and the instant claims is that the claims of '814 require a "dental additive". It would have been obvious to one skilled in the art at the time of the invention to omit the dental additive in the claims of '814 in order to provide a composition for coating or film-forming instead of for a dental application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-10, 12 and 17-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 and 21-23 of copending Application No. 10/847,523. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The difference between the claims of Application No. 10/847,523 and the instant claims is that the claims of '523 recite an arylsulfinate salt and a sensitizing compound while the instant claims recite the same arylsulfinate salt and an electron acceptor. Farid et al (4,859,572) disclose an initiator system for ethylenically unsaturated components comprising an electron acceptor activator, an electron donor activator and a dye photosensitizer. The electron donor can be an arylsulfinate (column 8, line 7). The photosensitizers disclosed are dyes, corresponding to the

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photosensitizing dyes set forth in claims 21-22 of '523 (column 10. Electron acceptor compounds, include sulfonium salts and iodonium salts, are also disclosed (column 8, lines 51-68). It would have been obvious to one skilled in the art at the time of the invention to include an electron acceptor, such as an iodonium salt or sulfonium salt taught by Farid et al, in the compositions set forth in the claims of '523. Farid et al provide motivation by teaching compositions comprising an electron donor such as an arylsulfinate salt and a photosensitizer, as set forth in the claims of '523, and an electron acceptor, as set forth in the instant claims. Farid et al provide motivation by teaching that sulfonium salts and iodonium salts are useful electron acceptor compounds in compositions comprising an arylsulfinate salt and a photosensitizer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

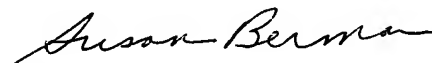
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB  
8/5/05



Susan W Berman  
Primary Examiner  
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